No. __-____

Supreme Court, U.S.
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IN THE

Supreme Court of the United States

OCTOBER TERM, 1997

HOWARD A. FROMSON,

Petitioner,

—v.—

ANITEC PRINTING PLATES, INC., JAMES R. SULLIVAN AND THOMAS P. RORKE,

Respondent.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

PETITION FOR WRIT OF CERTIORARI

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QUESTION PRESENTED

When construing a patent claim, as a matter of public policy, should "extrinsic" evidence such as expert testimony be relied upon to construe a claim term where "intrinsic" evidence, consisting of the claims, patent specification and the prosecution history, establishes that the meaning of the term is unambiguous?

LIST OF PARTIES

The parties to the proceedings below were the Petitioner, Howard A. Fromson and the Respondents, Anitec Printing Plates, Inc., James R. Sullivan and Thomas P. Rorke.

The Respondents before this Court are Anitec Printing Plates, Inc., James R. Sullivan and Thomas P. Rorke.

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PETITION FOR WRIT OF CERTIORARI

The Petitioner Howard A. Fromson respectfully prays that a writ of certiorari issue to review the judgment and opinion of the United States Court of Appeals for the Federal Circuit, entered in the above-entitled proceeding on December 30, 1997. A petition for rehearing was timely filed but denied by that court on February 23, 1998.

OPINIONS BELOW

The opinion of the Court of Appeals for the Federal Circuit is reported at 132 F.3d 1437, 45 U.S.P.Q.2d (BNA) 1269, and is reprinted in the appendix ("App.") beginning at App. 1a.

The denial of the Petition for Rehearing and Suggestion for Rehearing En Banc has not been reported and is reprinted beginning at App. 21a.

The District Court's order entering judgment for Defendant dated March 15, 1996 has not been reported and is reprinted beginning at App. 23a.

The District Court's Memorandum and Order entering judgment for Defendant dated March 15, 1996 has not been reported and is reprinted beginning at App. 25a.

The District Court's Oral Findings of Fact and Conclusion of Law, entered March 14, 1996, are reported at 39 U.S.P.Q.2d (BNA) 1727 and are reprinted beginning at App. 28a.

JURISDICTION

Jurisdiction in the United States District Court for the District of Massachusetts was based on 28 U.S.C. §§ 1331 and 1338(a). The appeal to the United States Court of Appeals for the Federal Circuit was timely taken pursuant to the provisions of 28 U.S.C. §§ 1295(a) and 2107. The jurisdiction of this Court to review the judgment of the Federal Circuit is invoked under 28 U.S.C. § 1254(1). The judgment of the Federal Circuit sought to be reviewed was entered on December 30, 1997, and after a timely Petition for Rehearing and Suggestion for Rehearing En Banc was filed on January 12, 1998, the order denying rehearing was entered on February 23, 1998.

FEDERAL STATUTES

28 U.S.C. § 2106 Determination

The Supreme Court or any other court of appellate jurisdiction may affirm, modify, vacate, set aside or reverse any judgment, decree, or order of a court lawfully brought before it for review, and may remand the cause and direct the entry of such appropriate judgment, decree, or order, or require such further proceedings to be had as may be just under the circumstances.

35 U.S.C. §103 Conditions for patentability; nonobvious subject matter.

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject mater pertains. Patentability shall not be negatived by the manner in which the invention was made.

* * *

35 U.S.C. § 112 Specification

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

* * *

The full text of 35 U.S.C. §§ 103 and 112 is reprinted beginning at App. 51a.

STATEMENT OF THE CASE

On February 11, 1975, Howard Fromson was issued U.S. Patent

No. 3,865,700 for a Process and Apparatus for Continuously Anodizing Aluminum (the " '700 patent"). The '700 patent originally had ten claims and was reissued in 1978 as Reissue Patent No. 29,754 with original claim 2 and new claims 11-20 (the " '754 patent"). The '754 patent, which expired on February 11, 1992, is reprinted beginning at App. 119a.

Fromson's patent specification, like all patent specifications, is addressed to one of ordinary skill in the art, in this case the art of anodizing aluminum.

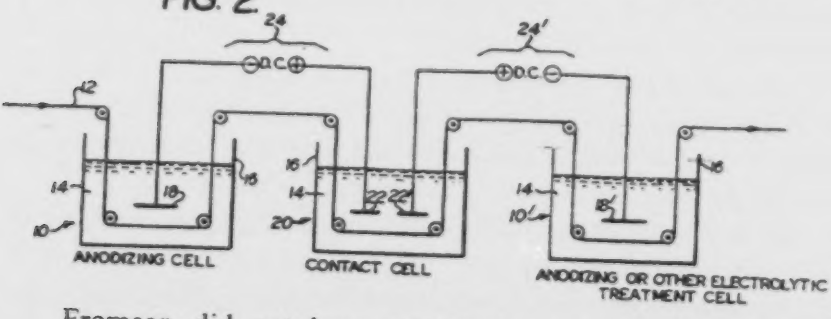
Fromson Improves the Art of Anodizing.

According to the specification, "[i]n its broadest terms, the present invention provides an improvement in a process for continuously electrolytically anodizing aluminum web using direct current." App. 123a.

Fromson prefers to form an anodized oxide coating in two steps using two sources of direct current. "This can be accomplished by using a cathodic contact cell, in which the aluminum web is cathodic, between two anodizing cells in which the aluminum strip is anodic[.]" App. 125a.

Figure 2 of the patent, reproduced below, schematically depicts apparatus for carrying out the preferred process where a portion of the oxide is formed in anodizing cell 10 before the aluminum web 12 passes through contact cell 20 and the balance to reach the desired oxide thickness is formed in anodizing cell 10'. See App. 124a.

FIG. 2



Fromson did not have to tell those knowledgeable about anodizing what they already knew; their knowledge was presumed and is present as if written out in the patent specification. *In re Johnson*, 48 C.C.P.A. 733, 282 F.2d 370, 372-373, 760 O.G. 1041,

127 U.S.P.Q. (BNA) 216, 218 (C.C.P.A. 1960)("The terms 'insecticides' and 'fungicides' are terms of general knowledge and application in this art. A person having the ordinary skills in the art would be presumed to know the meaning of these terms as defined in Hackh's Chemical Dictionary (3rd Ed.)... He also would be presumed to know what the [] Encyclopedia says of fungicides.").

To enable those of ordinary skill in the art of anodizing to use his invention, Fromson needed to describe only what was new, not what was known in the art at the time of his invention. *In re Hayes Microcomputer Products Inc. Patent Litigation*, 982 F.2d 1527, 1534, 25 U.S.P.Q.2d 1241, 1246 (Fed. Cir. 1992) (["A]n inventor is not required to describe every detail of his invention. An applicant's disclosure obligation varies according to the art to which the invention pertains."); *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1556, 220 U.S.P.Q. 303, 315 (Fed. Cir. 1983)(citing *In re Storrs*, 245 F.2d 474, 478, 114 U.S.P.Q. (BNA) 293, 296-97, 44 C.C.P.A. 981, 1957 Dec. Comm'r Pat. 361 (C.C.P.A. 1957)("Patents, however, are written to enable those skilled in the art to practice the invention, not the public.").

The Ordinary Meaning of Anodizing.

In describing his invention to one of ordinary skill in the art of anodizing aluminum, Fromson used the term of art, "anodizing" much the same way an inventor of a plastic or metal cladding, for example, would use terms of art like "polymerization" or "electroplating" when addressing persons of ordinary skill in those arts. In these circumstances, "anodizing" is given its ordinary meaning in the art. See *Ekchian v. Home Depot, Inc.*, 104 F.3d 1299, 1303, 41 U.S.P.Q.2d 1364, 1367 (Fed. Cir. 1997)("because the specification does not use the term 'conductive' in a special or unique way, its ordinary meaning to one skilled in the art controls.").

Dictionaries are reliable sources of the ordinary meaning of words. Webster's Third International Dictionary defines "anodize" as "to subject (a metal) to electrolytic action by making (it) the anode of a cell..." App. 150a. The Federal Circuit cites to this definition but omits the word "electrolytic" before "action." *Fromson*, 132 F.3d at 1444, 45 U.S.P.Q.2d at 1273, App. 11a.

A definition of anodizing, which is essentially the same as

Webster's, can be taken from Fromson's '754 patent: anodizing is electrolytically forming an oxide coating by subjecting an aluminum web to the action of direct current by making the web the anode of a cell. App. 123a-125a ("Summary," paragraphs 1 and 2; "Description," paragraph 1).

In his examples, which were "not intended to limit or otherwise restrict the invention in any way," App. 127a, Fromson describes conditions for forming a porous anodic oxide coating, a further preferred embodiment.

Fromson's Patent Claims use Anodizing in the Ordinary Way.

Fromson's claims vary in scope, consistent with preferred embodiments described in the specification. Claims 2, 11, 13, 14 and 15 were asserted.

Claims 2 and 11, reproduced below, describe an improvement in the art of anodizing and embrace the concept of using two sources of direct current to form an oxide coating in two steps.

> 2. In a process for continuously electrolytically anodizing aluminum, the improvement which comprises introducing anodizing direct current from two or more sources in a cathodic contact cell having theirin anodes connected to said sources of direct current, the aluminum having an anodized oxide coating formed thereon before entering said cell through the action of the direct current introduced in the contact cell itself.
>
> 11. In a process for continuously electrolytically anodizing a moving aluminum web using the cathodic contact cell technique, the improvement which comprises introducing anodizing direct current from at least two direct current sources into said moving aluminum web into at least two cross-sections thereof, portion of the anodizing being carried out before the aluminum web enters the contact cell.

See App. 132a and 133a-134a.

Claim 13, reproduced below, incorporates claim 11 and broadly covers the preferred process of Figure 2 using two anodizing cells to form the oxide in two steps.

> 13. Process of claim 11 wherein the anodizing current is introduced into said moving aluminum web by using a contact cell between two anodizing cells whereby anodizing current introduced from a first source of direct current into the first cross-section of said web flows in a direction opposite to the direction of movement of said web and anodizing current introduced from a second source of direct current into the second cross-section of the web flows in the direction of movement of said web.

See App. 134a.

Claims 14 and 15 parallel claims 2, 11 and 13 but are narrower in scope by requiring the formation of the preferred porous coating, a limitation notably *absent* from claims 2, 11 and 13. See App. 134a-135a.

Claims 14 and 15 reflect Fromson's intent to claim his invention broadly as disclosed in his specification (App. 123a - 124a) and more narrowly, specifically reciting the formation of a porous oxide coating as disclosed in the specification. See App. 134a-135a and compare claim 2, 11 and 13 with claims 14 and 15.

The term "anodizing" is used uniformly and consistently throughout the public record of the '754 patent which consists of the claims, the specification and the prosecution histories of the original and reissue patents. The public record is void of any conflict or inconsistency suggesting that the term "anodizing" has different meanings or is limited to specific anodizing conditions. Compare, for example, App. 123a-124a, with App. 127a.

At no time during the prosecution of the original '700 patent or the '754 patent did the patent examiner object to the specification as not containing "a written description...in such full, clear, concise and exact terms as to enable any person skilled in the art to make and use same." 35 U.S.C. §112, paragraph 2. Nor did the patent examiner reject any of Fromson's claims as not "particularly pointing out and distinctly claiming the subject mater which the applicant regards as

his invention." 35 U.S.C. §112, paragraph 2.

The purpose of Section 112 of the patent statute is to avoid the kind of ambiguity that allows the introduction of extrinsic evidence, *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 986, 34 U.S.P.Q.2d 1321, 1335 (Fed. Cir. 1995) (en banc) *"Markman I," aff'd*, 517 U.S.___, 116 S.Ct. 1384, 134 L.Ed. 2d 577, 38 U.S.P.Q.2d (BNA) 1461 (1996) (*"Markman II"*).

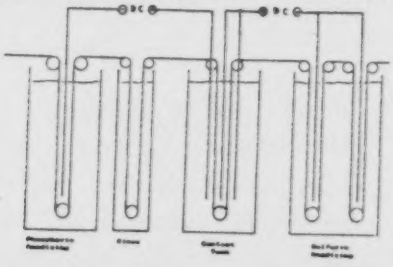
Thus, if "the patent's claims are sufficiently unambiguous for the PTO, there should exist no factual ambiguity when those same claims are later construed by a court of law in an infringement action." *Id.*

Anitec's Infringement Admitted.

Anitec Printing Plates, Inc. ("Anitec"), at a time when a predecessor company had been sued by Fromson on a different patent also involving anodizing (see *Fromson v. Advanced Offset Plate, Inc.*, 720 F.2d 1565, 219 U.S.P.Q. (BNA) 1137 (Fed. Cir. 1983) and *Fromson v. Advanced Offset Plate, Inc.*, 755 F.2d 1549, 225 U.S.P.Q. 26 (Fed. Cir. 1985)), and with knowledge of Fromson's '700 patent soon after it issued, began using Fromson's patented process to anodize aluminum in two anodizing cells on either side of a contact cell using two sources of direct current, just like Figure 2 of the '754 patent, App. 121a. Anitec used hot phosphoric acid as the electrolyte in the first anodizing cell and sulfuric acid in the second to form an oxide coating in two steps, just like Fromson.

During a bench trial, to prove infringement, Fromson put into evidence undisputed internal documents prepared by Anitec scientists admitting that anodizing was carried out in both anodizing cells, thus admitting infringement. See App. 137a-143a and App. 144a-149a.

These documents contain a diagram of Anitec's anodizing section, reproduced below, which, except for a rinse tank between phosphoric anodizing and the contact cell, is essentially identical to Figure 2 of Fromson's patent reproduced above.



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Anitec admits that if forms a thick sulfated anodized oxide in the sulfuric anodizing tank under a thin phosphated anodized oxide formed in the phosphoric anodizing tank. The phosphated oxide controls adhesion and release of a coating and enhances shelf life and run length of the printing plate product. See App. 140a and compare App. 146a and App. 148a-149a.

To aid the trial court in further understanding the technology of anodizing, Fromson introduced patent documents to establish that others of ordinary skill believed, at the time of Anitec's infringement, that the electrolytic treatment of aluminum under the conditions used by Anitec in its phosphoric acid tank was anodizing. See App. 151a-179a.

Anitec maintained that its admitted use of anodizing in the first tank was not "anodizing" as that term was used by Fromson in his patent. Anitec took the position, supported by the testimony of three trial experts and technical literature, that the term "anodizing" should be limited to the formation of a thick, porous anodic oxide, thus excluding the thin, nonporous anodic oxide it created in the first tank from the scope of Fromson's claims.

The Trial Court, Affirmed by the Federal Circuit, Redefined "Anodizing" Using Extrinsic Evidence.

The Fromson trial court, citing *Markman I*, made a two-step infringements analysis: "First, the meaning and scope of the asserted claims must be determined. Second these claims as construed must be compared to Anitec's accused process." *Fromson v. Anitec Printing Plates Inc.*, 39 U.S.P.Q.2d (BNA) 1727, 1732 (D.C. Mass. 1996), App. 39a.

In so construing Fromson's claims, the trial court credited Anitec's experts and other extrinsic evidence and adopted a definition of anodizing "as the defendants have proposed it," *Fromson*, 3 U.S.P.Q.2d at 1733, App. 41a, that precluded Anitec's admission that it was anodizing in the first tank.

> And I conclude...that the terms "anodization," "anodized coating," and "anodized oxide coating" under Markman mean an electrolytically formed, adherent, porous aluminum oxide coating sufficiently thick (meaning thicker

> than native oxide) to, (A) protect against the burning and arcing problems addressed by the patent and optionally, (B) to provide a suitable porous base for other electrolytic treatments in the second anodizing cell such as electrophoresis, e-l-e-c-t-r-o-p-h-o-r-e-s-i-s, for metal plating.

The trial court considered extrinsic evidence to determine the meaning and scope of "anodizing" "given the slipperiness of the term..." *Id.*, App. 40a.

No Finding of Ambiguity.

However, the trial court made no finding that the term "anodizing," as it appears in the public record of the '754 patent, was ambiguous or "slippery" or was used in a way that different meanings could be implied.

On appeal, the Federal Circuit upheld the finding of non-infringement, holding that the "district court's findings of scientific/technologic fact were material to the issue of construction of the term 'anodizing.'" *Fromson v. Anitec Printing Plates Inc.*, 132 F.3d 1437, 1444, 45 U.S.P.Q.2d (BNA) 1269, 1274 (Fed. Cir. 1997), App. 13a.

Invalidity Holding Reversed.

Although the '754 patent had been expired for more than four years, the trial court, after finding non-infringement, held it invalid for obviousness over the prior art under 35 U.S.C. §103. *Fromson*, 39 U.S.P.Q.2d at 1736, App. 47a; App. 26a.

The Federal Circuit reversed the trial court's judgment of invalidity of the '754 patent. *Id.*, 132 F.3d at 1446-1447, 45 U.S.P.Q.2d at 1275-1276, App. 16a-19a.

Trial Court Jurisdiction.

The basis for federal jurisdiction in the Court of first instance is 28 U.S.C. §§ 1331 and 1338(a).

REASONS FOR GRANTING THE WRIT

I. The Federal Circuit Has Departed from *Markman I* and *Markman II* and Its Own Precedent by Allowing the Use of Expert Testimony and Other Extrinsic Evidence to Construe a Patent Claim Regardless of Whether the Public Record is Ambiguous.

In its landmark *Markman I* decision, the Federal Circuit held that the construction of terms of art within a patent claim is to be decided solely by the court as a matter of law. *Markman I*, 52 F.3d at 979, 34 U.S.P.Q. at 1329. This Court affirmed in *Markman II*, noting the importance of uniformity in construing patents. *Markman v. Westview Instruments, Inc.*, 517 U.S. __, 134 L.Ed. 2d 577, 116 S.Ct. 1384, 38 U.S.P.Q.2d (BNA) 1461, 1470 (1996).

Markman I also made it clear that "[e]xtrinsic evidence is to Ube used for the court's understanding of the patent, not for the purpose of varying or contradicting the term of the claims." 52 F.3d at 981, 34 U.S.P.Q.2d at 1331. This Court classified "constructing a term of art following receipt of evidence" as a "mongrel practice." *Markman II*, 116 S.Ct. at 1390, 38 U.S.P.Q.2d at 1465.

A line of Federal Circuit cases after *Markman I* and *Markman II* have established that "extrinsic" evidence must be excluded or given no weight where the "intrinstic" evidence, that is, the public record of a patent consisting of the claims, the patent specification and prosecution history, is unambiguous. See *Southwall Tech., Inc. v. Cardinal IG Co.*, 54 F.3d 1570, 1578, 34 U.S.P.Q.2d. (BNA) 1673, 1678 (Fed. Cir. 1995)("evidence extrinsic to the patent and prosecution history, such as expert testimony, cannot be relied on to change the meaning of the claims when that meaning is made clear by those documents."); *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1583, 39 U.S.P.Q.2d (BNA) 1573, 1577 (Fed. Cir. 1996)(Where "the public record *unambiguously* describes the scope of the patented invention, *reliance on any extrinsic evidence is improper.*"(emphasis added)); and *Bell & Howell Document Management Products Co. v. Altek Systems*, 132 F.3d 701, 706, 45 U.S.P.Q.2d (BNA) 1033, 1038 (Fed. Cir. 1997)("Patents should be interpreted on the basis of their intrinsic record, not on the testimony of such after-the-fact "experts" that played no part in the creation and prosecution of the patent.").

The Federal Circuit, in an opinion filed by Circuit Judge Newman, affirmed the trial court's use of extrinsic evidence to construe Fromson's claims:

> In this case the *technical experts not only aided the court's understanding of the technology, but they also provided evidence material to the interpretation of the claims. On this evidence the court enhanced the broadly stated dictionary definition of the process of anodization*, with the understanding of the finer points of the technology that was provided by witnesses during the trial.
>
> * * *
>
> Extrinsic evidence may be particularly helpful to the court when a specific technical aspect that is potentially of dispositive weight was not discussed in the specification or explored during the patent prosecution. *This case illustrates the use of extrinsic evidence in order to determine the meaning and scope of a technical term as the term is used in the claims.*

Fromson, 132 F.3d at 1444, 45 U.S.P.Q.2d at 1273-1274, App. 11a-12a (emphasis added).

Like the trial court, the Federal Circuit's decision is silent about any ambiguity in the public record as to the meaning of anodizing. No such ambiguity exists yet the *Fromson* court affirmed the trial court's use of extrinsic evidence to modify the meaning of "anodizing" as it is unambiguously used in the public record.

The *Fromson* decision makes no reference to the line of authority established by *Southwall*, *Vitronics* and *Bell & Howell*, which excludes or gives no weight to extrinsic evidence where the public record is unambiguous. In fact, it reaches an opposite result which, if allowed to stand, will bring chaos and uncertainty to the construction of patent claims by the district courts. Chaos, because no claim term or phrase will be isolated from litigation induced expert testimony regardless of whether the public record is ambiguous, and uncertainty, because the public will never know what the scope of a patent claim is until it is fully litigated.

The *Fromson* decision is clearly at odds with the holding in

Markman I that extrinsic evidence cannot be used "for the purpose of varying or contradicting the terms of the claims." *Markman I*, 52 F. 3d at 981, 34 U.S.P.Q.2d at 1331. That prohibition has been done away with in *Fromson* and *Markman I* has been relegated to "a useful general rule...adaptable to the needs of the particular case." *Id.*, 132 F.3d at 1444, 45 U.S.P.Q.2d at 1273, App. 11a.

The *Fromson* panel has thus made a significant departure from *Markman I* and the *Southwall* line of cases. This is made manifestly clear by Chief Judge Mayer, who wrote "separately to emphasize the incompleteness of this court's *Markman* [*I*] dissertation on the use of extrinsic evidence in construing patent claims." *Id.*, 132 F.3d at 1447, 45 U.S.P.Q.2d at 1276, App. 19a (Mayer concurring)(footnote omitted).

At first blush, Chief Judge Mayer seems ready to follow *Markman I* and *Southwall et al.*:

> If this were truly an exercise in construing words and concepts as a matter of law, absent any factual components, Fromson might well prevail; at least he would have my vote. I "know" what anodization means from my own undergraduate studies and experiments; the concept is not difficult and I need no further education to grasp it. I happen to have a dictionary in my chambers from the era pertinent here, which would confirm my "knowledge" about anodization. Fromson appeared to use the term without limit and, not surprisingly, so proclaims; even Anitec personnel called its process by the same name.

Fromson, 132 F.3d at 1447-1448, 45 U.S.P.Q.2d at 1277, App. 19a (Mayer concurring).

However, Chief Judge Mayer quickly turns and affirms the trial judge's construction of Fromson's claims using expert testimony and other evidence "so that he might develop the record and find the meaning of anodization, as used in this patent, to one skilled in the art in 1973." *Id.*, 132 F.3d at 1448, 45 U.S.P.Q.2d at 1277, App. 20a (Mayer concurring).

The split of authority between the *Southwall* line of cases and *Fromson* was foreshadowed by Judge Newman's lengthy dissent in

Markman I, (see especially the discussion of Technologic/Scientific Facts and The Testimony of Experts at *Markman I*, 52 F. 3d at 1004-1008), and has been confirmed, explained and expanded in dissenting opinions written by Chief Judge Mayer and Judge Newman in *Cybor Corp. v. FAS Techs. Inc.*, __ F.3d __, 46 U.S.P.Q.2d __ (Fed. Cir. Mar. 25, 1998), reprinted beginning at App. 54a. See App. 80a-99a (Mayer and Newman concurring in the judgment) and 112a-118a (additional views of Newman and Mayer).

II. *Fromson* was Decided Under a Clearly Erroneous Standard of Review and has Been Expressly Disavowed by the Federal Circuit Sitting *En Banc* in *Cybor*.

The use of extrinsic evidence by the trial court to construe Fromson's patent claims was reviewed under a clearly erroneous standard by a Federal Circuit panel that affirmed such use regardless of whether the claim term in dispute is ambiguous.

The use of the clearly erroneous standard in *Fromson* is clear from Judge Newman's opinion for the court:

> We affirm the construction of the claims as correct. We do not discern *clear error* in the court's application of the claims, as construed, to the accused process."

Id., 132 F.3d at 1445, App. 15a (emphasis added).

See also Chief Judge Mayer's concurring opinion:

> We are affirming [the trial judge's] claim construction as a matter of law based on the facts he found from conflicting evidence, which are not *clearly erroneous*.

Id., 132 F.3d at 1448, 45 U.S.P.Q.2d at 1277, App. 20a (emphasis added).

However, *Cybor*, decided after *Fromson*, disavowed previous opinions of the Federal Circuit employing a clearly erroneous standard, including *Fromson*, as in conflict with its holding that "as a purely legal question, we review claim construction *de novo* on

appeal including any allegedly fact-based question relating to claim construction." App. 64a.

See especially Chief Judge Mayer's dissent in *Cybor* and his discussion of the standard of review used in *Fromson* and other cases disavowed by the *Cybor* majority. App. 80a-99a (Mayer and Newman concurring in the judgment).

Thus, unless this Court rules otherwise, the wrong result reached in *Fromson*, both procedurally and substantively, will stand. It is equally compelling that had Fromson's appeal been assigned to a panel of judges from the *Cybor* majority, a different outcome would have resulted. See App. 180a.

III. The Federal Circuit Cannot Reconcile *Markman I* and the Use of Extrinsic Evidence in *Fromson*.

Senior Judge Archer, writing for the majority in *Cybor*, found it "difficult to reconcile the language and reasoning in this court's recent opinion in [*Fromson*] with *Markman I*, although the opinion purports to do so." App. 61a, n.5.

He then attempted, without success, to reconcile the trial court's use of extrinsic evidence with *Markman I* by finding that "the district court 'relied primarily on the '754 patent specification which describes Fromson's first anodization step as producing [a] porous oxide' barrier," App. 61a, n.5 (citing *Fromson*, 132 F.3d at 1442, 45 U.S.P.Q.2d (BNA) at 1272), whereas the use of extrinsic evidence at trial "was directed primarily to whether Anitec's thin, nonporous oxide layer infringed the claims." App. 61a, n.5.

This is incorrect on several grounds because it misapprehends the public record of Fromson's '754 patent, the trial record and the Federal Circuit's decision in *Fromson*. First, the decision, in no uncertain terms, adopts the trial court's use of extrinsic evidence to construe the term "anodizing" contrary to the public record:

> In this case the technical experts not only aided the court's understanding of the technology, but *they also provided evidence material to the interpretation of the claims.*
>
> * * *
>
> This case illustrates the *use of extrinsic evidence in order to determine the meaning and scope of a technical term as*

the term is used in the claims.

* * *

The District Court's findings of scientific/technologic fact were material to the issue of construction of the term "anodizing."

Fromson, 132 F.3d at 1444, 45 U.S.P.Q. at 1273-1274, App. 11a-13a (emphasis added).

Next, the trial court's finding "that in 1973 no reasonable practitioner of this process [anodizing] would have had the opinion that a non-porous non-adherent oxide coating...constituted an anodized surface" (*Fromson*, 39 U.S.P.Q. 2d at 1733, App. 41a) has no support in the '754 patent specification or prosecution histories and is based entirely on extrinsic evidence offered by Anitec at trial.

Lastly, to the extent that *Cybor* suggests that the '754 patent specification itself is sufficient basis for limiting the broad claims to a porous oxide coating, the analysis, if carried to conclusion, would hold that Fromson's claims can be restricted to a preferred embodiment, a conclusion not supported by the intrinsic evidence or the law. See *Ekchian*, 104 F.3d at 1303, 41 U.S.P.Q. at 1367. ("While examples disclosed in the preferred embodiments may aid in the proper interpretation of a claim term, the scope of a claim is not necessarily limited by such examples"); *Lantham Corp., v. Cambridge Mice Cloth Co.*, 863 F.2d 855, 865, 9 U.S.P.Q.2d (BNA) 1289, 1299 (Fed. Cir. 1988) ("References to a preferred embodiment, such as those often present in a specification, are not claim limitations"); *Texas Instruments, Inc., v. United States Int'l Trade Comm'n*, 805 F.2d 1558, 1563, 231 U.S.P.Q. (BNA) 833, 835 (Fed. Cir. 1986) ("This Court has cautioned against limiting the claimed invention to preferred embodiments or specific examples in the specification.").

It is thus clear that the decision in *Fromson* cannot be reconciled with the *Markman I* holding that "[e]xtrinsic evidence is to be used for the court's understanding of the patent, not for the purpose of varying or contradicting the terms of the claims." *Markman I*, 52 F.3d at 981, 34 U.S.P.Q. 2d at 1331. It is equally clear that the attempted reconciliation by the *Cybor* majority fails. App. 60a-61a at n. 5. The citations at the end of note 5 to *Bell & Howell* and *Vitronics*,

decisions not cited in *Fromson*, do not, without reaching a different result, move the rationale of *Fromson* from the extrinsic evidence camp to the public record camp.

IV. Federal Circuit Decisions Holding that Extrinsic Evidence Cannot be Used to Construe a Patent Claim Where the Public Record is Unambiguous are Based on Sound Public Policy.

This case presents an issue of importance to those who rely on public documents to construe the scope of a patent. The claims and specification of a patent, and its prosecution history, comprise the public record of a patent and are relied upon by competitors who, with some certainty, must be able to determine the scope of a claimed invention and compete without infringing.

The importance of the public record was emphasized in *Markman I:* ("it is from the public record that a court should seek in a patent infringement case to find the meaning of the claims." 52 F.3d at 987, 34 U.S.P.Q.2d at 1336) and by this court in *Markman II*:

> It has long been understood that a patent must describe the exact scope of an invention and its manufacture to "secure to [the patentee] all to which he is entitled, [and] to apprise the public of what is still open to them..."

116 S.Ct. at 1387, 134 L.Ed.2d at 581, 38 U.S.P.Q.2d. at 1463 (citing *McClain v. Ortmayer*, 141 U. S. 419, 424, 12 S.Ct. 76, 77, 35 L.Ed. 800 (1891)).

Southwall.

Approximately one month after *Markman I,* the Federal Circuit decided *Southwall* holding that:

> A patentee may not proffer an interpretation for the purposes of litigation that would alter the indisputable public record consisting of the claims, the specification and the prosecution history, and treat the claims as a "nose of wax." *Senmed, Inc.*, 888 F.2d 815, 819 n.8, 12 U.S.P.Q.2d at 1512 n.8.

Southwall, 54 F.3d at 1578, 34 U.S.P.Q.2d at 1678.

This applies to infringers as well as patentees who seek to alter the scope of patent claims. *Vitronics*, 90 F.3d at 1583, 39 U.S.P.Q.2d at 1577.

According to *Southwall*, any

> other rule would not be fair to competitors who must be able to rely on the patent documents, without consideration of *litigation induced expert opinion* that then does not even exist, in ascertaining the scope of a patentee's right to exclude.

Southwall, 54 F.3d at 1578, 34 U.S.P.Q.2d at 1978-1979 (emphasis added). Federal Circuit Judges Michel, Lourie and Bryson made up the *Southwall* panel. See App. 180a.

Vitronics.

Fourteen months later, on July 25, 1996, the Federal Circuit decided *Vitronics*, holding that the use of expert testimony and corporate documents to determine the meaning of a claim term already defined in the specification was improper because competitors are entitled to review the public record and

> apply the established rules of claim construction, ascertain the scope of the patentee's claimed invention, and, thus design around the claimed invention. *See Markman*, 52 F.3d at 978-79, 34 U.S.P.Q.2d at 1329. Allowing the public record to be altered or changed by extrinsic evidence introduced at trial, such as expert testimony, would make this right meaningless.

Vitronics, 90 F.3d at 1583, 39 U.S.P.Q.2d at 1577.

Judges Michel and Lourie were together again on the *Vitronics* panel and were joined by Circuit Judge Friedman. Judge Michel wrote the decisions in *Southwall* and *Vitronics*.

The *Vitronics* court set the standard for resolving ambiguity of a claim term:

> Only if there were still some genuine ambiguity in the claims, after consideration of all available intrinsic evidence, should the trial court have resorted to extrinsic evidence, such as expert testimony, in order to construe [the disputed claim.] ...the expert testimony, which was inconsistent with the specification and file history, should have been accorded no weight.

Vitronics, 90 F.3d at 1584, 39 U.S.P.Q.2d at 1578 (citing *Southwall*, 54 F.3d at 1578, and *Markman I*, 52 F.3d at 983).

In *Vitronics*, the phrase "solder reflow temperature" was in dispute. *Vitronics* argued that its patent specification established that the phrase as used in the claim in question meant peak reflow temperature rather than liquidus temperature. The trial court accepted expert testimony and technical articles showing that "solder reflow temperature" is the same as liquidus temperature. Based on this and other extrinsic evidence, the trial court ruled that solder reflow temperature meant the liquidus temperature.

The Federal Circuit reversed, finding that the meaning of the disputed claim phrase could be learned from the patent specification itself without reference to extrinsic evidence. *Vitronics*, 90 F.3d at 1583-1584, 39 U.S.P.Q.2d at 1577-78.

> The claims, specification, and file history, rather than extrinsic evidence, constitute the public record of the patentee's claim, a record on which the public is entitled to rely.

Id., 90 F.3d at 1583, 39 U.S.P.Q.2d 1577.

The *Vitronics* panel, in finding the use of extrinsic evidence by the trial court improper, re-emphasized the holdings in *Markman I* and *Southwall:* "extrinsic evidence in general, and expert testimony in particular, may be used only to help the court come to a proper understanding of the claims; it may not be used to vary or contradict the claim language." *Vitronics*, 90 F.3d at 1584, 39 U.S.P.Q.2d at

1578 (citing *Markman I*, 52 F.3d at 981). "Indeed, where the patent documents are unambiguous, expert testimony regarding the meaning of a claim is entitled to no weight." *Vitronics*, 90 F.3d at 1584, 39 U.S.P.Q.2d 1578 (citing *Southwall*, 54 F.3d at 1578).

> Had the district court [in *Vitronics*] relied on the expert testimony and other extrinsic evidence solely to help it understand the underlying technology, we could not say the district court was in error. But testimony on the *technology* is far different from other expert testimony...on the *proper construction* of a disputed claim term, relied on by the district court in this case. The latter kind of testimony may only be relied upon if the patent documents, taken as a whole, are insufficient to enable the court to construe disputed claim terms. Such instances will rarely, if ever, occur.

Vitronics, 90 F.3d at 1585, 39 U.S.P.Q.2d at 1579 (emphasis in original).

The *Vitronics* court expressed a preference, in those "rare instances" where extrinsic evidence is resorted to, for prior art references over expert testimony which "often only indicates what a particular expert believes a term means," whereas

> prior art documents and dictionaries, although to a lesser extent, are more objective and reliable guides. Unlike expert testimony, these sources are accessible to the public in advance of litigation. They are to be preferred over opinion testimony, whether by an attorney or artisan in the field of technology to which the patent is directed. Indeed, opinion testimony on claim construction should be treated with the utmost caution for it is no better than opinion testimony on the meaning of statutory terms.

Id.

In *Fromson*, litigation induced expert testimony was credited over patent documents contemporaneous with Anitec's infringement

describing phosphoric acid anodizing using the same conditions used by Anitec in its phosphoric anodizing tank. See App. 151a-179a.

As noted by *Vitronics*, even if expert testimony tended to show that others skilled in the art, under certain circumstances, understood a disputed claim term to have a meaning other than that established by the specification, such testimony can be given no weight in light of the unambiguous meaning shown in the specification. *Vitronics*, 90 F.3d at 1584, 39 U.S.P.Q.2d at 1579.

In *Fromson* the trial court's finding that "no reasonable practitioner of this process would have had the opinion that a non-porous non-adherent oxide coating, as thin as the native 5 nanometer coating found naturally in the environment, of post-phosphoric oxide constituted an anodized surface..." (*Fromson*, 39 U.S.P.Q.2d at 1733, App. 41a) was based entirely on the opinion of Anitec's trial experts and is entitled to no weight in view of the clear contrary meaning of "anodizing" shown in Fromson's '754 patent specification. Compare *Vitronics*, 90 F.3d at 1585, 39 U.S.P.Q.2d at 1579.

Bell & Howell.

Weeks before it decided *Fromson*, the Federal Circuit decided *Bell & Howell* reiterating the test for resolving ambiguities in claim construction developed in *Southwall* and *Vitronics*.

The *Bell & Howell* panel consisted of Chief Judge Archer and Circuit Judges Michel and Lourie. Judge Lourie delivered the opinion of the court, holding that

> reliance on extrinsic evidence to interpret claims is proper only when the claim language remains genuinely ambiguous after consideration of the intrinsic evidence, *Vitronics, 90 F.3d at 1584, 39 U.S.P.Q.2d at 1578*, i.e., when the intrinsic evidence is "insufficient to enable the court to construe disputed claim terms." *Id.* at 1585, 39 U.S.P.Q.2d at 1579.

Bell & Howell, 132 F.3d at 706, 45 U.S.P.Q.2d at 1038.

Bell & Howell vacated and remanded the denial of a preliminary injunction to the patent owner because the district court "erred in

construing the claims of the patents..." *Id.*, 132 F.3d at 702, 45 U.S.P.Q.2d at 1034.

The patents in suit in *Bell & Howell* related to jackets for holding microfiche strips and contained claims that called for *in situ* ribs bonded on both sides to panels. The claims required that the ribs be "integrally bonded" to the panels "free of adhesive." *Id.*, 132 F.3d at 703, 45 U.S.P.Q.2d at 1035. The claim language in quotes was in dispute and the lower court received expert testimony from both sides on the meaning of the language in question. The court accepted the testimony of the accused infringer's expert in construing the claims. *Id.*, 132 F.3d at 703, 45 U.S.P.Q. at 1035-36.

Relying on public policy precedent developed in *Southwall* and *Vitronics*, the Federal Circuit reversed, finding that "the court erred in relying on expert testimony to construe the expression 'integrally bonded...free of adhesive' because the *intrinsic evidence is clear and unambiguous*." *Id.*, 132 F.3d at 705, 45 U.S.P.Q.2d at 1037 (emphasis added).

The *Bell & Howell* court was especially critical of experts offering opinions long after the patents in suit issued:

> Once a dispute over claim construction arises, "experts" should also not be heard to inject a new meaning into terms that is inconsistent with what the inventor set forth in his or her patent and communicated, first to the patent examiner and ultimately to the public.

Id., 132 F.3d at 706, 45 U.S.P.Q.2d at 1038 (citing *Southwall*, 54 F.3d at 1578, 34 U.S.P.Q.2d at 1680).

V. The Federal Circuit Has Departed from its Own Precedent on Claim Differentiation in Allowing the Use of Extrinsic Evidence to Incorporate a Limitation from a Narrower Claim into a Broader Claim.

The claim differentiation doctrine *prohibits* the interpretation of the broader claims of a patent so as to import into such claims limitations specifically included in narrower claims of the same patent. See *United States v. Telectronics, Inc.*, 857 F.2d 778, 783-84,

8 U.S.P.Q.2d (BNA) 1217, 1221-22 (Fed. Cir. 1988), *cert. denied*, 490 U.S. 1046 (1989); *D.M.I., Inc. v. Deere & Co.*, 755 F.2d 1570, 1574, 225 U.S.P.Q. (BNA) 236, 239 (Fed. Cir. 1985)("Where some claims are broad and others narrow, the narrow claim limitations cannot be read into the broad. . . .")(quoting *Deere & Co. v. International Harvester Co.*, 658 F.2d 1137, 1141, 211 U.S.P.Q. (BNA) 11, 16 (7th Cir.), *cert. denied*, 454 U.S. 969 (1981)).

Each of *Fromson* claims 2, 11 and 13 specifies "a process for continuously electrolytically anodizing." App. 132a-134a. Each of independent claims 14 and 15, however, specifies a "[p]rocess for continuously forming a *porous* anodic oxide coating." App. 134a-135a.

The trial court defined anodizing using extrinsic evidence to exclude thin, non-porous oxide coatings and the Federal Circuit affirmed holding that the claim differentiation "doctrine can not, of itself, restore to Fromson's claim a scope that has been shown to be unwarranted." *Fromson*, 132 F.3d at 1445, 45 U.S.P.Q.2d at 1275, App. 14a.

This analysis is premised on the improper reliance on extrinsic evidence to vary an otherwise unambiguous public record and is contrary to public policy as stated by the *Southwall* line of cases.

VI. The Petition Should be Granted to Resolve an Intracircuit Conflict at the Federal Circuit on the Recurring and Important Issue of Claim Construction and the Standard of Appellate Review to Bring Uniformity to Claim Construction by the District Courts and the Federal Circuit Under *Markman I* and *Markman II*.

While *Cybor* takes the view that this Court endorsed the Federal Circuit's "role in providing national uniformity to the construction of a patent claim," App.62a, the views expressed in the opinions and remarks accompanying the majority decision in *Cybor* indicate that this goal will not be achieved unless this Court takes this case to resolve the split at the Federal Circuit regarding the use or exclusion of extrinsic evidence to construe patent claims. See App. 54a-76a.

Circuit Judge Plager concurred in *Cybor* noting that the case

> was taken en banc for the sole purpose of laying to rest any residual doubts about how, in claim construction, the verbalizations surrounding the familiar 'fact-law' dichotomy should be understood. I join the Court's opinions and judgment, eliminating the unnecessary obfuscation that seems to have emerged since our decision in [*Markman I*].

App. 76a (Plager concurring).

Chief Judge Mayer, joined by Judge Newman, concurred in the judgment but dissented from the majority opinion "because it profoundly misapprehends [*Markman II*]." App. 80a (Mayer and Newman concurring).

Compare Chief Judge Mayer's opinion in *Metaullics Systems Co. v Cooper*, 100 F.3d 938, 939, 40 U.S.P.Q.2d (BNA) 1798, 1799 (Fed. Cir. 1996), expressly disavowed by *Cybor*, App. 64a, with Judge Lourie's opinion concurring in the decision but disagreeing on the standard for appellate review. *Id.*, 100 F.3d at 939-940, 40 U.S.P.Q.2d at 1799-1800.

Judge Rader, joined by Judge Newman, dissented "from the pronouncements on claim interpretation in the en banc opinion." App. 99a (Rader and Newman dissenting).

Noting that the standard of review did not affect the outcome in *Cybor* because the court unanimously agreed in the judgment, and because the case was resolvable on the grounds, Judge Rader was critical of the majority's choice of *Cybor* "to state that it accords no deference to the district courts central role in patent litigation, namely claim interpretation." App. 99a. (Rader and Newman dissenting).

Judge Rader thus advanced the view that *Fromson* "may have been a more suitable choice for meaningful en banc consideration of the issue of appellate deference in claim construction" and concluded that "the facts of Fromson might have better illustrated how different standards of review can direct the outcome on appeal." App. 101a, n. 13 (Rader and Newman dissenting).

Judge Rader thus seems to concede that *Fromson* would have been decided differently had the Federal Circuit reviewed *Fromson* using the *de novo* standard of review established by *Cybor* after

Fromson was decided.

Judge Newman's additional views, joined in by Chief Judge Mayer, are in open opposition to the holdings in *Southwall*, *Vitronics* and *Bell & Howell*, discussed *supra*.

> The Federal Circuit's ruling that extrinsic evidence must be restricted unless there is a facial ambiguity in the meaning of the claim is an unnecessary restraint on potentially useful evidence.
>
> * * *
>
> Of course the primary source of information concerning the claimed invention is the patent documents. But such documents are directed to persons knowledgeable in the field; additional evidence and expert testimony as to their meaning should be the rule, not the exception. So-called "extrinsic" evidence - the evidence of expert witnesses and of experimentation, exhibits, demonstrations, and explanation - should be treated like any other evidence, and received and given weight and value as appropriate. Our broad constraint on resort to such evidence is an unnecessary bar to enlightenment."
>
> * * *
>
> Thus it is quite discouraging to observe this en banc ruling wherein the Federal Circuit prohibits itself from considering the findings of fact made by the trial court. The majority opinion disavows this court's prior statement [in *Fromson*] that "the district court's findings of scientific/technological fact were material to the issue of construction of the term." This disavowal deprives the court, and the parties, of the accumulated progress and experience of the trial, including the findings of the trial judge, and leaves us on appeal with an expurgated record and generally inferior basis of decision. Recognizing that our appellate role is to decide whether the claims were correctly interpreted in light of all of the evidence, it is mysterious why we choose to self-censor what we will consider on appeal. It is equally obscure why this court would prohibit itself from relying on a trial court's findings, or from choosing between disputed expert

> positions. I strongly disagree with the majority's view of the role of extrinsic evidence, at trial and as considered on appeal.

App. 116a-118a (additional views of Newman and Mayer).

Openly acknowledging the different views at the Federal Circuit on the relevance or non-relevance of extrinsic evidence in claim construction, Judge Newman suggests that *this Court should intervene*:

> These flaws are of serious concern, no less because they are of our own making. They are not irremediable, although remedy may require a larger vision than we possess.

App.113a (additional views of Newman and Mayer).

This intracircuit conflict must be resolved by this Court. The conflict is more than an intramural matter because it relates to the recurring and important issue of claim construction. Certiorari has been granted under similar circumstances. See, e.g., *John Hancock Ins. Co. v. Bartels*, 308 U.S. 180, 181 (1939)(certiorari granted because of intracircuit conflict and the importance of the question); *Dickinson v. Petroleum Conversion Corp.*, 338 U.S. 507, 508 (1950) (certiorari granted "because of this intracircuit conflict"); *Maggio v. Zeitz*, 333 U.S. 56, 59-60 (1948)(certiorari granted because of differing views within a circuit that was most frequently confronted with difficult bankruptcy problems); *Scarborough v. United States*, 431 U.S. 563, 567 n. 4 (1977)(certiorari granted because of "split among the Circuits," one circuit being noted as having an intracircuit conflict).

VII. Alternatively, this Court Should Vacate and Remand Under 28 USC § 2106.

28 USC § 2106 enables this Court to "require such further proceedings to be had as may be just under the circumstances."

For the reasons stated herein, this Court should vacate and

remand to the Federal Circuit for reconsideration en banc of its decision in *Fromson* in light of *Markman I* and *II*, the *Southwall* line of decisions and *Cybor*. See *United States Surgical Corp. v. Ethicon Inc.*, 517 U.S. 1164, 116 S.Ct. 1562, 134 L.Ed.2d 662 (1996) where this Court vacated and remanded to the Federal Circuit for further consideration in light of its decision in *Markman II* and *Panduit Corp. v. Dennison Manufacturing Co.*, 475 U.S. 809, 106 S.Ct. 1578, 89 L.Ed.2d 817, 229 U.S.P.Q. (BNA) 478 (1986) where this Court vacated and remanded to the Federal Circuit for further consideration in light of Rule 52(a).

CONCLUSION

For the reasons stated, this Petition for Certiorari should be granted. Alternatively, the case should be vacated and remanded for further proceedings as ordered by the Court.

Respectfully submitted,

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